

Remarks

Claims 1-20 remain pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claim Status

Claims 1-6 and 17-18 were rejected under 35 U.S.C. § 103(a) over Hanna (US 6,761,308) in view of Do (US 6,293,207).

Claims 7-13, 15-16, and 19 were objected to but indicated allowable if written in an independent form.

Claims 14 and 20 were allowed.

The Amendments

Claims 7 and 10 have been written in an independent format as requested by the Office. Thus, Applicant respectfully submits that claims 7-14 and 20 stand allowed and need not be discussed further herein.

35 U.S.C. § 103(c)

Applicant's application was filed before the applied Hanna reference was issued as a patent. In the prior Office Action dated May 4, 2005, the Office stated that "Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e)". The prior Office Action (on page 2) also stated that "The applied reference has a common assignee with the instant application". In the Office's stated scenario, according to 35 U.S.C. § 103(c), while Hanna might qualify as prior art in a 35 U.S.C. § 102(e) rejection, it is not a proper basis for a 35 U.S.C. § 103(a) rejection.

The 35 U.S.C. § 103(a) Rejections

Even disregarding the Office's above stated scenario regarding Hanna, the applied references still would not teach or suggest the recited features and relationships. The applied references are also devoid of any teaching, suggestion, or motivation for combining features of thereof to produce Applicant's invention. The Office has not established a *prima facie* case of obviousness.

Claim 1

Claim 1 recites that the machine includes a door in hinged connection with a machine body portion. The machine also includes a hinge cover arrangement. The hinge cover arrangement includes both a hinge cover and a linkage. The hinge cover is operatively connected to the door via the linkage. The hinge cover is also operative to move relative to the door responsive to movement of the door.

The Action admits that Hanna does not teach or suggest that the alleged hinge cover (46) can move relative to the door (160) responsive to movement of the door. That is, the Action admits that Hanna does not teach or suggest the recited hinge cover. It follows that Hanna cannot teach or suggest the recited combination and relationship of hinge cover and linkage.

The Action alleges that Do teaches an ATM safe that includes a hinge cover (49) that can move relative to the door (17) responsive to movement of the door. The Applicant respectfully disagrees with the interpretation and application of Do.

Do's extended hinge plate (49) does not constitute a hinge cover. Where does the hinge plate (49) cover a hinge? The hinge plate (49) conventionally connects the door (17) to the hinge blocks (41, 43). Thus, the hinge plate (49) appears to be part of the hinge. Nor does the plate

(49) conceal hinges, as the Office apparently alleges. Rather, the plate (49) rotates on the hinge blocks (41, 43). The internally mounted hinge blocks (41, 43) are concealed (by the door, not the plate) when the door is closed.

As previously discussed, claim 1 recites both a hinge cover and a linkage. Even if it were somehow possible (which it isn't) for Do's plate (49) to constitute a hinge cover, Do still would not teach or suggest the recited linkage. It follows that Do (like Hanna) cannot teach or suggest the recited combination (and relationship) of hinge cover and linkage.

The Office apparently attempts to add the alleged hinge cover (49) of Do to Hanna. However, the Office is silent as to how Hanna could be modified with the teaching of Do to have produced the recited invention of claim 1, as alleged. Where does the Action explain how Hanna could be modified by Do to have produced the recited invention? Since the Action does not explain the rejection with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Nor would it have been obvious to one having ordinary skill in the art to have modified Hanna with the teachings of Do to have produced the recited invention. The structural arrangement and components of Do and Hanna are neither compatible nor interchangeable. Hanna lacks the recited hinge cover, as admitted by the Office. Do (even with the alleged hinge cover 49) lacks the recited linkage.

Furthermore, Hanna has an external hinge arrangement, whereas Do has an internal hinge arrangement. Do's plate (49) would not function with an external hinge arrangement (such as Hanna's arrangement) because the door (with the plate in the way) would not be able to fully close.

In the Office's description of Hanna the door (160) is connected to the hinge cover (46) via the intermediate linkage (272). In the Office's description of Do the door (17) is connected to the hinge blocks (41, 43) via the intermediate hinge cover (49). Further, the alleged hinge cover (46) in Hanna is exterior of the door (160), whereas the alleged hinge cover (49) in Do is interior of the door (17). That is, Hanna has an outer door arrangement, whereas Do has an inner door arrangement. Again, the structures of Hanna and Do are not compatible.

The structures and components of Hanna and Do serve completely different purposes. One having ordinary skill in the art would not have looked to modify Hanna's exterior hinge arrangement with Do's interior hinge arrangement. Nor would the modification be structurally feasible or practicable.

The Office has not provided any prior art teaching, suggestion, or motivation for the alleged modification of Hanna with the teaching of Do. The references do not teach or suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The recited features and relationships patentably distinguish over the applied references.

The only suggestion for the recited features and relationships is found in Applicant's own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Applicant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The addition of Do's plate (49) to Hanna would be directly contrary to Hanna's explicit teaching and would destroy the disclosed and desired utility and operability of the Hanna teaching. That is, the alleged modification to Hanna would render the reference inoperable for its

intended and desired purpose. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Even if it were somehow possible (which it isn't) for Hanna to be modified to include Do's plate (49) as alleged, the modification still would not result in the recited invention. A modified Hanna would still lack both a hinge cover and a linkage, and the relationship therebetween, in the manner recited.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest the recited features and relationships. It would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Applicant respectfully submits the rejection of claim 1 is improper and should be withdrawn.

The Dependent Claims

The Applicant respectfully traverses the rejections of the recited dependent claims. The applied art also does not teach or suggest the dependent claims. Each of the rejected dependent claims depends directly or indirectly from independent claim 1. The Applicant has shown independent claim 1 to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art. For example, claim 5 recites that the first member is in operative connection with the machine body portion (of claim

1). The Action (at page 3, lines 11-15) alleges that Hanna teaches a linkage having a first member (272). This alleged first member (272) is in operative connection with the door (160). Where is this alleged first member (272) in operative connection with the machine's body portion? Applicant respectfully submits that claim 5 is allowable.

Additionally, the allegation of Hanna's elements 184 and 186 as linkage members is unclear as these elements do not relate to the alleged hinge cover (46). Claim 1 relates the hinge cover and the door via the linkage. Claim 3 relates the hinge cover and the first linkage member.

The references, taken alone or in combination, do not teach or suggest the recited features and relationships. Nor has the Action established a *prima facie* case of obviousness.

Fee For Extra Independent Claims

Five (5) independent claims are pending. Please charge the fee associated with the submission of two additional independent claims (\$400) and any other fee due to Deposit Account 09-0428.

Conclusion

Applicant respectfully submits that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


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